

## REMARKS

In the Official Action dated December 26, 2001, the Examiner rejected pending claims 1-24 as being obvious in light of Chen et. al., U.S. Patent No. 5,822,506 together with various combinations of Ikegaya et. al., U.S. Patent No. 5,263,129, Matysek et. al., U.S. Patent No. 5,442,732, Yamada, U.S. Patent No. 5,798,738, Olarig, U.S. Patent No. 5,878,237, Campbell, Jr. et. al., U.S. Patent No. 5,172,326, and/or Ng, U.S. Patent No. 5,455,681.

Applicant has made several amendments to the specification and drawings to correct minor errors. Applicant respectfully submits that no new matter has been added by these amendments. Support may be found throughout the specification.

Applicant intends to make no admissions by the following remarks, but rather hopes to clarify the present invention in an effort to promote allowance of the pending claims.

For the reasons set forth below, applicant traverses the rejections and requests reconsideration.

### ***Response to Rejections under 35 U.S.C. § 103(a)***

#### ***Claims 1 and 5:***

The Examiner rejected claims 1 and 5 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Matysek.

According to MPEP § 2142, in order to establish a *prima facie* case of obviousness, there must be 1) some suggestion or motivation to modify a reference or to combine teachings from multiple references, 2) a reasonable expectation of success; and 3) the references so combined must teach or suggest all the claim limitations.

A. The Examiner Has Shown No Motivation Or Suggestion To Combine The Cited References.

Rather than specifically state any reasons for combining references, the Examiner simply listed the advantages that would result after the cited references were combined. For example, the Examiner stated that a printed instruction sheet for a remote device (which the Examiner claims would result from combining Chen and Ikegaya) is easy to carry and would thus be better than trying to remember instructions viewed on a remote monitor. This advantage is not disclosed in any of the cited references, but is taught in applicant's disclosure itself: "By carrying the printed instruction sheet to the finishing device 42, the operator is able to refer to the instruction sheet while performing the necessary setup operations at the remote finishing device 42, obviating the need for the operator to remember the instructions and enabling the operator to re-check the settings without walking back to the printer user interface 22." (Application at page 8, lines 19-23).

There is no need to carry an instruction sheet in Ikegaya, because Ikegaya discloses printing an instruction sheet for the very device that printed it, a fax machine. Similarly, there is no need to carry a printed instruction sheet in Chen, because Chen uses "post processor control data to direct modifications to be made to said printed sheet," that is, under the control of a processor and without operator setup. (Col. 7, lines 27-35). Using an advantage only found in applicant's invention against applicant is impermissible hindsight, and cannot serve as a motivation to combine references.

Moreover, the Examiner relies on Chen as the basis for all the limitations in claims 1 and 5 except: 1) printing an instruction sheet and 2) a printer having a printer user interface. According to MPEP § 2143.01, "if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the

teachings of the references are not sufficient to render the claims *prima facie* obvious.” (Citing *In re Ratti*, 270 F.2d 810 (CCPA 1959)). If Chen, however, were modified as suggested by the Examiner, the principle of operation of Chen would have to be changed; Chen discloses a method that includes “sending said separated post processor control data from the printer to the intelligent post processor; receiving the post processor control data at the intelligent post printer processor; and modifying at least one of the printed sheets in the print job at the intelligent post printer processor, using the post processor control data to direct modifications to be made to said printed sheet.” (Col. 7, lines 27-35). Thus, to remove (and print) setup data at the printer before it reaches a finishing device, as claimed in applicant’s invention, Chen’s principle of operation would have to be modified to 1) eliminate the step of sending control data from the printer to the intelligent post processor, and to 2) eliminate the step of receiving the control data at the post processor. Therefore, the disclosures of Chen and Ikegaya are not sufficient to render claims 1 and 5 *prima facie* obvious.

In addition, Ikegaya discloses an apparatus that prints an instruction sheet that is necessarily placed on a “coordinates input screen” of the same device to which the instructions relate. (Col 8, lines 12-13). There would thus be no motivation to combine Ikegaya with another reference to print an instruction sheet that includes instructions for a finishing device that is not the same device that printed the instructions, as applicant has claimed.

B. The Combined References Do Not Yield The Claimed Invention.

Combining Chen and Ikegaya and Matysek does not yield the applicant’s invention. Ikegaya does not disclose or suggest an apparatus that receives setup instructions for a finishing device, the instructions included as part of a print job. Ikegaya only discloses an apparatus that

prints a page from an instruction manual for the same device that prints the page, while Chen, as the Examiner noted, does “not teach printing an instruction sheet listing setup operations,” and in fact teaches away from a printed instruction sheet, as discussed above. Matysek is only cited as disclosing a printer with a printer user interface, and does not include any of the above-discussed limitations. Because neither Ikegaya nor Chen nor Matysek show or suggest a method that includes printing setup instructions for a finishing device, and because there is no motivation to combine Ikegaya and Chen, applicant requests notice of allowance of claims 1 and 5. Claims 2-4 and 6-8 depend ultimately from claims 1 and 5. Allowance of claims 2-4 and 6-8 will therefore follow directly from claims 1 and 5.

***Claims 9, 13, 17, and 21:***

The Examiner rejected claims 9, 13, 17, and 21 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya. As discussed in detail above, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed. Therefore, applicant believes claims 9, 13, 17, and 21 to be in condition for allowance, and requests notice to that effect. Claims 10-12, 14-16, 18-20, and 22-24 depend ultimately from claims 9, 13, 17, and 21. Allowance of claims 10-12, 14-16, 18-20, and 22-24 will therefore follow directly from allowance of claims 9, 13, 17, and 21.

***Claims 3, 4, 7, and 8:***

The Examiner rejected claims 3, 4, 7, and 8 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Matysek as applied to claims 1 and 5 above, and

further in view of Yamada. As discussed in detail above with reference to claims 1 and 5, from which claims 3, 4, 7, and 8 depend, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed. The Examiner cited Yamada for disclosing a print job entered through a network. Yamada, however, adds nothing new to the lack of motivation or disclosure of all the claimed limitations as already discussed; thus the combination of Chen, Ikegaya, and Matysek fails to render claims 3, 4, 7, and 8 obvious. Notice of allowance of claims 3, 4, 7, and 8 is therefore requested.

***Claims 11, 12, 15, 16, 19, 20, 23, and 24:***

The Examiner rejected claims 11, 12, 15, 16, 19, 20, 23, and 24 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Yamada. As discussed in detail above, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed. Therefore, because the base claims from which claims 11, 12, 15, 16, 19, 20, 23, and 24 ultimately depend are allowable, claims 11, 12, 15, 16, 19, 20, 23, and 24 are allowable.

Additionally, in rejecting claims 12, 16, 20, and 23, the Examiner cited Yamada for disclosing a “printer which is a stand-alone unit including a scanner that provides image data to the printer.” In this regard, Yamada adds nothing new to the lack of motivation or disclosure of all the claimed limitations as already discussed with reference to the base claims 9, 13, 17, and 21 from which they depend; thus the combination of Chen, Ikegaya, and Matysek fails to render claims 12, 16, 20, and 23, obvious.

Furthermore, the Examiner has not articulated a motivation to combine Chen and Ikegaya with Yamada, other than to list advantages that could be realized after the combination is made, which is merely using impermissible hindsight.

Claims 11 and 15 are allowable because they depend from allowable base claims, as discussed above. Claims 11 and 15 are also independently allowable because in rejecting claims 11 and 15, the Examiner cited Yamada for disclosing "print jobs [received] through a network." Yamada, however, does not remedy the lack of motivation or disclosure of all the claimed limitations as already discussed, nor is any motivation for combining Chen and Ikegaya with Yamada articulated; thus the combination of Chen, Ikegaya, and Yamada fails to render claims 11 and 15 obvious.

In rejecting claims 19 and 24, the Examiner cited Yamada for disclosing print jobs set up through a network. Claims 19 and 24 are allowable because they depend from allowable base claims, as discussed above, and because Yamada adds nothing to the lack of motivation or disclosure of all the claimed limitations as already discussed with reference to base claims 17 and 21, from which claims 19 and 24 depend. Further, there is no motivation to combine Yamada with either Chen or Ikegaya because Yamada has no need for instruction sheets and does not disclose or suggest a discrete finishing device as claimed; thus the combination of Chen, Ikegaya, and Yamada fails to render claims 19 and 24 obvious.

Notice of allowance of claims 11, 12, 15, 16, 19, 20, 23, and 24 is therefore requested.

***Claims 10, 14, 18, and 22:***

The Examiner rejected claims 10, 14, 18, and 22 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Olarig. As discussed in detail above, there is no

motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed, also discussed above. Therefore, because the base claims from which claims 10, 14, 18, and 22 ultimately depend are allowable, claims 10, 14, 18, and 22 are allowable.

***Claims 2 and 6:***

The Examiner rejected claims 2 and 6 under 35 U.S.C. § 103(a) as being unpatentable over Chen in view of Ikegaya and Matysek as applied to claims 1 and 5, and in further view of Campbell and Ng. As discussed in detail above, there is no motivation to combine Chen and Ikegaya, and in fact, Chen teaches against such a combination. Further, the combination of Chen and Ikegaya does not yield the invention as claimed, also discussed above. Thus, a *prima facie* case of obviousness regarding claims 1 and 5 has not been established by the combination of Chen and Ikegaya. Because claims 2 and 6 depend ultimately from claims 1 and 5, allowance of claims 2 and 6 will follow directly from the allowance of claims 1 and 5.

As further discussed above, Matysek does not cure the deficiency of Chen and Ikegaya with regard to rendering claims 1 and 5 or claims 2 and 6 obvious. Therefore, because the base claims (1 and 5) from which claims 2 and 6 ultimately depend are allowable, claims 2 and 6 are allowable.

In rejecting claims 2 and 6, the Examiner stated that Chen in view of Ikegaya and Matysek do not teach: “a. accessing a database of setup instructions that are to be performed on the at least one finishing device; b. retrieving a file from the database containing instructions for a specified finishing device; and c. reading the file.” The Examiner further stated that Campbell discloses all of the above elements, and that it would have been obvious to combine Campbell with Chen, Ikegaya and Matysek.

To make out a *prima facie* case of obviousness as required by 35 U.S.C. § 103(a), each cited reference must be in an art analogous to the art of the invention. At the outset, it should be noted that Campbell does not apply to applicant's field of endeavor. In particular, Campbell shows a "method and system for cutting a web, such as a patterned fabric." (Abstract). This is not an analogous field to that of the invention, which relates to printing methods and systems. Further, there is no motivation to combine Campbell with any of the other references cited in the Office Action. Rather, the Examiner has simply recited the advantages that would result if the references were combined to arrive at applicant's invention, assuming *arguendo* that the cited combination would yield the claimed invention (which applicant does not admit). Since Campbell does not have a finishing device or even a printer associated with a finishing device, it is unfathomable that one of ordinary skill in the art would find any motivation or suggestion there to combine Campbell with Chen, Ikegaya and Matysek to print an instruction sheet for a finishing device. Therefore, combining Campbell with Chen, Ikegaya and Matysek requires resort to impermissible hindsight.

Next, the Examiner observes that neither Campbell, Chen, Ikegaya, nor Matysek teaches a page description file that is rasterized and incorporated into a printed instruction sheet, and then states that Ng discloses those elements. As with Campbell, Ng does not disclose a printer with an associated printing device, nor does anything in Ng show or suggest a need for an instruction sheet, printed or otherwise, directed as it is to "transform[ing] a high resolution binary data file to a lower resolution grey level file for printing by a lower resolution printer." (Abstract). Thus, Ng is not analogous art, and even if it is found to be analogous, there is no motivation or suggestion to combine Ng with the other references cited to arrive at the claimed invention. The Examiner's recitation of advantages that could be realized by the incongruous



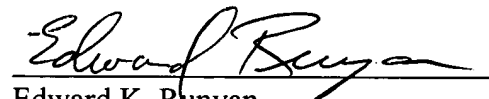
combination of Campbell, Chen, Ikegaya, Matysek, and Ng is hindsight, not motivation or suggestion to combine. Because claims 2 and 6 depend from allowable claims 1 and 5, and for the independent reasons stated above, applicant believes claims 2 and 6 to be in condition for allowance, and requests notice to that effect.

### **CONCLUSION**

Applicant submits that the present application is now in condition for allowance, and notice to that effect is hereby requested. Should the Examiner feel that further dialog would advance the subject application to issuance, he is invited to telephone the undersigned at any time.

Respectfully submitted,

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Paragraph beginning at page 5, line 24:

The marking engine **40** also includes output devices that transfer the printed out pages to one or more finishing devices **42** connected to the printer **20** by a simple electrical connection **12**. The finishing device **42** includes a finishing device user interface ~~[43]~~33. The finishing device **42** may be any commonly used finishing device, such as a hole punch or binder.

Paragraph beginning at page 5, line 29

The printer **20** includes a logic control [center]unit 50, including a printer user interface **22**, through which the operator inputs functions and receives messages from the printer **20**. The printer **20** also includes a database **60** of shared instructions, stored on a local disk, accessed by the RIP. The instructions stored in the database include, for example, setup instructions for a particular finishing device that are to be followed by the operator in all cases, regardless of the particular configuration chosen. Generally, these instructions will include directions as to how to physically set up a given finishing device. For example, a hole punch may have detents that must be physically moved to a desired position, but are secured by spring-loaded pins that must be removed prior to moving the detents. Likewise, the shared instructions may remind the operator to power down a particular finishing device prior to performing setup operations thereon, should that step be necessary.